

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte HARRY LIU, LONNY BERG,  
WILLIAM L. LARSON,  
SHAOPINGLI, THEODORE ZHU,  
and JOEL DREWES

MAILED

JUL 7 - 2006

PAT & TM OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application No. 10/646,103

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on June 27, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

October 17, 2005, appellants filed an Appeal Brief. A review of the file reveals that the Summary of Claimed Subject Matter does not map the claimed invention to the independent claims as required by 37 CFR § 41.37(c)(1)(v), which states:

(v) ***Summary of claimed subject matter.*** A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the

structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

In addition, An Information Disclosure Statement (IDS) was filed on January 4, 2006. A review of file reveals that the examiner has not considered the IDS. According to MPEP § 609 which states:

". . . . The Examiner must also fill in his or her name and the date the information was considered in blocks at the bottom of the PTO-1449 or PTO/SB/08A and 08B form."

Accordingly, it is

**ORDERED** that the application is returned to the Examiner to:

- 1) hold the Appeal Brief of October 17, 2005 defective;
- 2) request applicants to file a substitute Appeal Brief in compliance with 37 CFR § 41.37;
- 3) for the examiner to consider the substitute Appeal Brief, and if necessary, vacate the Examiner's Answer mailed November 23, 2005, and issue a revised Examiner's Answer in accordance with the new rules effective September 13, 2004;

- 4) for consideration of the IDS filed January 4, 2006; and
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By:



DALE M. SHAW  
Deputy Chief Appeal Administrator  
(571) 272-9797

DMS/dal

KNOBBE, MARTENS, OLSON & BEAR, LLP  
2040 MAIN STREET  
FOURTEENTH FLR.  
IRVINE, CA 92614